

## **REMARKS**

Claims 1-10 are now pending in the application. Claims 1 and 4 are amended to more clearly describe the claimed features and overcome the rejection under 35 U.S.C. § 112. The claims retain their original scope and the amendments are not narrowing in effect. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

### **REJECTION UNDER OBVIOUSNESS-TYPE DOUBLE PATENTING**

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as allegedly unpatentable over claim 25 of U.S. Patent 5,952,065, Mitchell et al. This rejection is respectfully traversed.

Claim 1 is drawn to a gas-filled cushioning device that includes a multi-layer film having an inner first layer and a second outer layer. Figure 5; paragraph [0065]. The first layer includes a blend of at least one aliphatic thermoplastic polyurethane and at least one copolymer of ethylene and vinyl alcohol, wherein the first layer includes up to about 50 wt. % of the at least one aliphatic thermoplastic polyurethane. Paragraphs [0068], [0081]-[0084]. The second outer layer includes a flexible resilient elastomeric thermoplastic material. Paragraphs [0066]-[0067]

In contrast, claim 25 of Mitchell does not include or suggest features of the presently claimed inner first layer and therefore cannot establish a case of obviousness-type double patenting. The analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. See *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). However, the obviousness inquiry is limited to the claim's language in view of the specification, where the double patenting claim itself must suggest all of the present claim limitations, as the disclosure of the patent is generally not available as prior art. See *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992) (inquiry is based on whether the claim is an obvious variation while the disclosure of the patent may not be used as prior art). In this case, claim 25 of Mitchell fails to disclose a blend of aliphatic thermoplastic polyurethane and ethylene and vinyl alcohol copolymer.

Claim 25 of Mitchell discloses a cushioning device having a membrane having outer (i.e., the first layer) and inner (i.e., the second layer) layers. The outer layer includes thermoplastic urethanes (TPU). The inner layer includes one or more materials selected from the group consisting of co-polymers of ethylene and vinyl alcohol, polyvinylidene chloride, co-polymers of acrylonitrile and methyl acrylate, such as BAREX™ which is a trademarked product of the British Petroleum Co., polyesters such as PET (Polyetheneterephelate), aliphatic and aromatic polyamides, liquid crystal polymers, and polyurethane engineering thermoplastics such as ISOPLAST, a trademark of Dow Chemical Co. Mitchell col. 9, lines 43-52. Note that polyurethane engineering thermoplastic (e.g., ISOPLAST™ from Dow Chemical Co.) is a different material from thermoplastic urethanes (e.g., PELLETHANE™ from Dow Chemical Co.). Cf. Mitchell col. 9, lines 32-34, 50-52; see [<http://plastics.dow.com/about/specialty.htm>] and technical datasheets therein. And in particular, nowhere does claim 25 of Mitchell disclose a blend of ethylene vinyl alcohol copolymer with *aliphatic* thermoplastic urethane.

Mitchell claim 25 is therefore silent with respect to the presently claimed inner first layer that includes a blend of aliphatic thermoplastic polyurethane and ethylene and vinyl alcohol copolymer. Moreover, Mitchell further fails to disclose a first layer that includes up to about 50 wt. % of the at least one aliphatic thermoplastic polyurethane as found in claim 1. No reason is provided in the present rejection as to why a person of ordinary skill would include this missing subject matter, either based on the Mitchell disclosure or the general knowledge in the art. Consequently, independent claim 1 is not obvious and is patentably distinct over claim 25 of Mitchell.

What is more, a device constructed according to claim 1 provides surprising and unexpected results as compared to Mitchell claim 25. For example, Sample 3 of the present application illustrates a barrier layer of 90% ethylene vinyl alcohol (EVOH) and 10% aliphatic thermoplastic urethane (ATPU) that is coextruded with one layer of thermoplastic urethane (TPU). Paragraph [0124]. Sample 3 has a gas transmission rate of 1.62, as shown in Table 1. In contrast, the membranes described in Mitchell require *three* layers of TPU laminated to EVOH to achieve a similar gas transmission rate of 1.92, as illustrated in Figure 19. Claim 25 of Mitchell only discloses *two* layers

and therefore cannot achieve the effects provided by the present claims having additional features. Thus, the present barrier membranes that include aliphatic thermoplastic urethane unexpectedly produce a slightly better gas transmission rate while using only half the total number of layers in comparison to claim 25 of Mitchell.

As such, claim 1 is nonobvious and patentably distinct over claim 25 of Mitchell. Applicants respectfully request reconsideration of the claims and withdrawal of the rejection.

#### **REJECTION UNDER 35 U.S.C. § 112**

Claims 1 and 4 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention.

With respect to the term "combination" in claims 1 and 4, Applicants have amended these claims to change "combination" to "blend" as suggested by the Examiner. Support is found in the original specification, including paragraphs [0083] and [0084].

With respect to the phrase "at least one aliphatic thermoplastic polyurethane" in claim 1, Applicants have amended the second instance of this feature to read "the at least one aliphatic thermoplastic polyurethane" to more clearly identify the antecedent basis for the second instance. Applicants submit that it is clear that the aliphatic thermoplastic polyurethane is part of the first layer.

Reconsideration of the claims and withdrawal of the rejection are respectfully requested.

#### **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-10 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Mitchell et al. (U.S. Pat. No. 5,952,065). This rejection is respectfully traversed.

The Mitchell patent fails to disclose all of the presently claimed features. Namely, Mitchell does not disclose a blend of aliphatic thermoplastic polyurethane and ethylene and vinyl alcohol copolymer or a first layer that includes up to about 50 wt. % of the at least one aliphatic thermoplastic polyurethane. Consequently, the Mitchell

patent cannot anticipate the present claims. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (each and every element in the claim must be present in the reference for the claim to be anticipated).

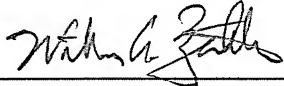
Applicants respectfully request reconsideration of the claims and withdrawal of the rejection.

### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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